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Paper No. 20
BAC

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Burrell Mining Products, Inc.

Serial No. 74/693,924

Julie K. Morriss of Trask, Britt & Rossa for Burrell Mining
Products, Inc.

Albert J. Zervas, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney).

Before Hohein, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Burrell Mining Products, Inc. has filed an application
to register the mark shown below

for "non-metal mine roof supports or props, namely posts" in International Class 19.¹ The application is based on applicant's allegation of a bona fide intention to use the mark in commerce. Applicant filed an amendment to allege use on December 20, 1995 (via certificate of mailing)², asserting dates of first use and first use in commerce of August 3, 1995. The specimen submitted by applicant is reproduced below.

Registration has been finally refused pursuant to Trademark Rule 2.51(a)(2) on the ground that applicant has

¹ Application Serial No. 74/693,924, filed June 26, 1995. The application includes statements that the lining and the stippling are for shading purposes only and do not indicate color.

² This paper was not immediately associated with the application file, however, and the application was published for opposition on April 16, 1996, and a notice of allowance issued on July 9, 1996. The amendment to allege use was treated by the Office as a statement of use.

not submitted proper specimens showing use of the mark shown in the drawing.³

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse.

The Examining Attorney has required that applicant submit specimens showing the mark without the words "BURRELL MINING PRODUCTS INC.," and an affidavit or declaration that the substitute specimens were in use as of a date prior to the expiration of the time allowed for applicant to file a statement of use. The Examining Attorney contends that applicant's corporate name, BURRELL MINING PRODUCTS, INC., is an integral part or inseparable element of the mark shown on the specimen, but the corporate name does not appear in the drawing of the applied-for mark; and that, therefore, applicant has not provided a specimen which is a substantially exact representation of the mark shown in the drawing as required by Trademark Rule 2.51(a)(2). ("Alternatively stated, the mark shown on the drawing page is an incomplete

³ The Examining Attorney made clear that under Trademark Rule 2.72(a), "applicant cannot amend the drawing to conform to the display on the specimens because the character of the mark would be materially altered." (Office action dated December 16, 1996.) The applicant did not attempt to change the mark, and therefore, the possible issue of a material alteration of the mark is not before us.

representation of the mark shown in the specimen and the applicant has 'mutilated' the mark as actually used."

(Examining Attorney's brief, p. 2.)⁴

Applicant contends that the appearance of its corporate name on the specimens is merely extraneous and informational, as is applicant's address, telephone number, and patent information; and that the applied-for mark creates a separate commercial impression without applicant's corporate name, or any of the other informational material shown on the specimen.⁵

As explained in 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §19:59 (4th ed. 1998):

"Mutilation" refers to a situation where a seller seeks registration of something less than the totality of his trademark. That is, the seller "mutilates" his trademark, severs a part of it, and seeks registration only of that part. The Patent and Trademark Office may then reject registration, saying that the applicant is trying to register something less than his full trademark, thereby attempting to obtain protection for an element that is only his in combination with other words or symbols. (footnote and citations omitted).

⁴ The Examining Attorney expresses the issue before the Board as "whether the specimen depicts a substantially exact representation of the mark shown in the drawing." (Brief, p. 2)

⁵ Applicant expresses the issue before the Board as whether the applied-for mark creates a separate commercial impression apart from applicant's corporate name (Appeal brief, p. 3); and in the reply brief, applicant challenges the Examining Attorney's statement of the issue because it presumes what the mark is, when the issue before the Board involves a determination of what the mark is. (Reply brief, p. 2).

The whole problem is one of definition: what exactly is the "trademark"? Once defined, the designation sought for registration is compared to that "trademark." If less than the total "trademark," then what is sought is a registration of a "mutilated" version of the mark. In defining the scope of the "trademark" the applicant will argue that the designation he applies for does, in fact, function in and of itself as a trademark. That is, there may be a lot of printed matter on a label, but he has culled out exactly that element which serves to distinguish his product from others.

The specimens submitted by applicant unquestionably show the applied-for mark, but they also include numerous words and numbers (applicant's corporate name and address, applicant's telephone number, as well as patent information). The Examining Attorney does not assert that any of the other material on the specimen, other than applicant's corporate name, is involved in his requirement for substitute specimens. Rather, the Examining Attorney simply does not accept that the applied-for mark creates a separate commercial impression without applicant's corporate name as it appears on the specimens.⁶

⁶ The case cited by the Examining Attorney, *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988), is inapposite here. The Chemical Dynamics case involved a background design (a picture of a watering can with a medicine dropper and droplet) with a word mark (7 DROPS), and there the applicant sought to register only a part of the background design, namely the medicine dropper and droplet. The case now before the Board does not involve the applicant attempting to register an incomplete and inseparable portion of a background design. To the contrary, applicant seeks to register the entire background design, plus the sitting miner and the words THE CAN.

We agree with applicant that its applied-for mark is registrable without its corporate name. In fact, as argued by applicant, if such matter had been included on the drawing, the Examining Attorney may have required removal or disclaimer of such material. See TMEP §807.13(a). That is, applicant's drawing presents a substantially exact representation of the mark as actually used in commerce, and applicant need not submit new specimens showing the mark without the corporate name.

We acknowledge that this decision is subjective, but we cannot agree with the Examining Attorney's assessment of applicant's drawing vis-a-vis the mark shown on the specimens. Rather, the commercial impression of the applied-for mark is separable from applicant's corporate name as it appears on the specimens of record.

Decision: The requirement for different specimens is reversed.

G. D. Hohein

C. E. Walters

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board